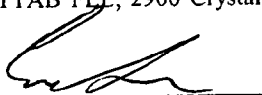


CERTIFICATE OF MAILING BY EXPRESS MAIL

The undersigned hereby certifies that the foregoing NOTICE OF OPPOSITION is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on **September 23, 2003** and is addressed to the Commissioner for Trademarks, Box TTAB FEE, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

Express Mail Label No. EV270962880US


Eric A. Lerner

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

-----X	
McGRAW-EDISON COMPANY,	: Mark: GROUP EDISON
	: (STYLIZED)
	:
Opposer,	: Opposition No. _____
	:
v.	: Serial No.: 76/208,603
	:
RICHARD H. TAMIAN,	: Class: 42
	:
Applicant.	: _____
-----X	


09-23-2003
U.S. Patent & TMO/TM Mail Rcpt Dt. #22

Box TTAB FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

NOTICE OF OPPOSITION

Sir:

McGRAW-EDISON COMPANY ("Opposer"), a Delaware corporation, with offices at 600 Travis, Suite 5800, Houston, Texas 77002, believes that it is or will be damaged by registration by Richard H. Tamian, ("Applicant") an individual at 69 Edison Terrace, Sparta New

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Jersey 07871, of U.S. Serial Number 76/208,603, for the mark GROUP EDISON (Stylized), and
Opposer hereby opposes same:

As grounds for Opposition against the Application, Opposer alleges, upon information
and belief, that:

**ALLEGATIONS COMMON TO
ALL GROUNDS FOR OPPOSITION**

Applicant's Trademark Application

1. Applicant filed Serial Number 76/208,603 on February 12, 2001 based its use the
mark GROUP EDISON (Stylized) (the "Applicant's Mark", depicted below) on or in connection
with the sale of "Intellectual property consultation in the field of acquireing intellectual property
for others" in International Class 42 (the "Application").

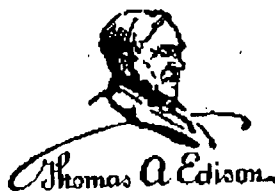
GROUP ΣDISON

2. Registrant alleges first use of his mark on December 20, 2000.
3. Applicant's Mark was published for opposition in the Official Gazette of August
26, 2003.

09/20/2007TAS

Opposer's Trademarks

4. Opposer is the owner of all rights to the trademarks "THOMAS A. EDISON" and "EDISON" (both in block letter, signature and other logo formats)(collectively the "EDISON Trademarks") for a variety of consumer and electronic products, including computer hardware and software, electric switches and relays, indoor and outdoor electric light fixtures, and circuit protection devices. The following are some examples of the signature and logo formats of the EDISON Trademarks:



5. Opposer is also the owner of the commercial rights to the name, likeness, and signature of Thomas A. Edison.

6. Thomas Edison is recognized as one of the most distinguished inventors of the Twentieth Century. Among his great achievements is the invention in 1879 of electric light and of power generation technologies to light the modern world. Throughout this century, Thomas Edison and his company, Thomas A. Edison, Incorporated, and its successor companies, including Opposer, have marketed such diverse products as phonographs, sound records, sound

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recording equipment, dictation equipment, temperature indicator equipment, telephone and conference recording equipment, shaving machines, electric motors, electrical batteries, flashing signal apparatus, portable electrical lighting outfits, electric hand lamps, radio battery and receiving sets, vapor lamps, electrical household appliances, loud speakers, oscillators, attenuators, audio amplifiers, microphones, electric heaters, electric switches and relays, fire detection devices, industrial and aircraft instruments, aeronautical accessories, railway air conditioning control systems, electric charge testing devices, battery chargers, voltage regulators, transformers and x-ray machines.

7. Through a century of commercial activity by Thomas Edison and associated enterprises, the Edison name and EDISON Trademarks have become among the most famous in the world. Because of Edison's many contributions to the advancement of science and technology, his name and the EDISON Trademarks have acquired worldwide renown, particularly in the field of electronic products. Edison was granted nearly 1,100 U.S. Patents for his contributions to the useful arts and sciences.

8. Prior to his death in 1931, Thomas Edison made arrangements for the continued commercial use and protection of the EDISON Trademarks, and his name, likeness, and signature, by assigning them to his company, Thomas A. Edison, Incorporated, of West Orange, New Jersey. Among the concerns addressed by Edison in the Assignment, dated November 24, 1930 (attached as **Exhibit A**), was the need to protect the public against deception from unauthorized uses of the EDISON Trademarks and his name, likeness, and signature. The Assignment provides in part:

I am informed and believe that the capital invested in American Industries based upon or substantially affected by my inventions and discoveries exceeds twenty billion dollars. I realize that the public has for a great many years associated my

name with the industries based upon my inventions and discoveries and also with the articles of commerce manufactured by the companies in which I am interested. I do not wish my name to be used for commercial purposes indiscriminately by concerns with which I have had no association. . . . I realize also that the public has placed faith and credit in the industries that use my name with my authority and in the articles of commerce manufactured by the companies in which I am interested. I desire, as completely as possible, to protect the industries which rightfully use my name, to justify the public's faith in my name in these industries, and to prevent, as far as I may be able to do so, the unauthorized commercial use of my name, portrait and signature.

In furtherance of these purposes, I, Thomas A. Edison, of West Orange, New Jersey, therefore assign, transfer and convey to you, Thomas A. Edison, Incorporated, a New Jersey corporation, having your principal office at West Orange, New Jersey, your successors and assigns, all rights not heretofore conveyed, in and to the names EDISON and THOMAS A. EDISON for commercial purposes and for the promotion of research and inventions in whatsoever forms the same may be used, including my signature, which is now extensively used as a trade mark by you; and also my rights for the use for commercial purposes of all portraits, photographs and pictures of myself.

It is my desire that no persons or concerns, not duly authorized so to do, shall use my name, signature or portrait for commercial purposes unless permission be first obtained from you, your successors or assigns, and I trust that my wish will be respected, but if not I direct that unauthorized users of my name, signature or portrait be vigorously prosecuted.

9. McGraw-Edison Company of Elgin, Illinois ("McGraw-Edison (IL)") was the successor to Thomas A. Edison, Incorporated. Opposer is a successor to McGraw-Edison (IL) and presently owns the rights to the EDISON Trademarks and to Thomas Edison's name, likeness, and signature.

10. Since at least 1958, McGraw-Edison (IL) and, later, Opposer have used the EDISON Trademarks in the marketing of electronic products, including lighting fixtures, ceiling fans, humidifiers and air conditioners. In recent years, Opposer has used the marks through its licensees, including Edison Lighting of Schaumburg, Illinois.

00/20/560877AE

11. As a result of the worldwide renown of Thomas Edison's name and the EDISON Trademarks, those marks have acquired enormous goodwill and consumer recognition of substantial value to Opposer.

12. Opposer's marketing and sale of products bearing the EDISON Trademarks have also created substantial licensing opportunities in the consumer electronics and household appliances fields for the EDISON Trademarks. Opposer has licensed and is actively engaged in negotiations to license those trademarks for diverse electronic and appliance products.

Opposer's Federal Registrations

13. Opposer is the owner of valid and subsisting federal registrations for the EDISON Trademarks, including, among others, the following:

Trademark	:	EDISON
Reg. No.	:	0,372,127
Reg. Date	:	October 24, 1939
Goods	:	Electrical switches and electric relays.
Intl Class	:	9
First Use	:	July 23, 1936

Trademark	:	EDISON
Reg. No.	:	0,409,187
Reg. Date	:	September 19, 1944
Goods	:	Indicating instruments; namely, temperature indicators and indicating instruments or units each comprising an assembly of a temperature indicator, a pressure gauge, and a differential pressure gauge
Intl Class	:	9
First Use	:	June 1940

Trademark	:	EDISON
Reg. No.	:	1,288,874
Reg. Date	:	August 7, 1984
Goods	:	Indoor and outdoor electric light fixtures
Intl Class	:	9
First Use	:	September 1, 1974

Trademark	:	EDISON
Reg. No.	:	1,636,822
Reg. Date	:	March 5, 1991
Goods	:	Electric lighting fixtures
Intl Class	:	9
First Use	:	August 24, 1987
Trademark	:	THOMAS A. EDISON (Signature Logo)
Reg. No.	:	2,443,841
Reg. Date	:	April 17, 2001
Goods	:	Electric lighting fixtures and components and fittings therefore
Intl Class	:	11
First Use	:	January 1958
Trademark	:	THOMAS A. EDISON (Bust Logo)
Reg. No.	:	2,452,699
Reg. Date	:	May 22, 2001
Intl Class	:	11
Goods	:	Electric lighting fixtures and components and fittings therefore
First Use	:	September 30, 1997
Trademark	:	THOMAS A. EDISON
Reg. No.	:	2,495,399
Reg. Date	:	October 9, 2001
Goods	:	Electrical lighting fixtures and components therefore; namely, electric ballasts, electrical transformers and track lighting units.
Intl Class	:	11
First Use	:	January 1958

14. The foregoing registrations constitute prima facie or conclusive evidence of the validity of Opposer's EDISON Trademarks, of the registrations for each mark, and of Opposer's exclusive right to use each mark in commerce in connection with the goods specified in each registration.

15. Opposer is also the owner of United States Trademark Registration No. 1,644,681 for the mark THOMAS A. EDISON TECHNICAL CENTER for services in the power generation field.

16. In addition, Opposer has filed the following trademark applications, which are currently pending in the United States Patent and Trademark Office:

Trademark : **THOMAS A. EDISON** (Signature & Bust Logo)
 Serial No. : 75/841,438
 Filing Date : November 5, 1999
 Int'l Class : 11
 Goods : Electric lighting fixtures and components and fittings therefore in Class 11
 First Use : September 30, 1997

Trademark : **THOMAS A. EDISON** (Block Letters)
 Serial No. : 75/714,056
 Filing Date : May 26, 1999 (Intent-To-Use)
 Int'l Classes : 7, 11
 Goods : Clothes washing machines and drying machines, dishwashers, garbage disposals...food processors, and parts, accessories and fittings therefore in Class 7;

Refrigerators and freezers... electric lighting fixtures; and repair and replacement parts, accessories and controls therefore in Class 11

Trademark : **THOMAS A. EDISON** (Signature Logo)
 Serial No. : 75/714,055
 Filing Date : May 26, 1999 (Intent-To-Use)
 Int'l Class : 7, 11
 Goods : Clothes washing machines and drying machines, dishwashers, garbage disposals...food processors, and parts, accessories and fittings therefore in Class 7;
 Refrigerators and freezers... electric lighting fixtures; and repair and replacement parts, accessories and controls therefore in Class 11

Trademark : **THOMAS A. EDISON** (Signature & Bust Logo)
 Serial No. : 75/714,065
 Filing Date : May 26, 1999 (Intent-To-Use)
 Int'l Class : 7, 11
 Goods : Clothes washing machines and drying machines, dishwashers, garbage disposals...food processors, and parts, accessories and fittings therefore in Class 7;

Refrigerators and freezers... electric lighting fixtures; and repair and replacement parts, accessories and controls therefore in Class 11

Trademark : **THOMAS A. EDISON** (Bust Design)
 Serial No. : 75/714,073
 Filing Date : May 26, 1999 (Intent-To-Use)
 Int'l Class : 7, 11
 Goods : Clothes washing machines and drying machines, dishwashers, garbage disposals...food processors, and parts, accessories and fittings therefore in Class 7;

Refrigerators and freezers... electric lighting fixtures; and repair and replacement parts, accessories and controls therefore in Class 11

17. As set forth above, Opposer's use of Opposer's EDISON Trademarks commenced prior to Applicant's earliest claimed priority date in the Application, and Opposer's applications for the EDISON Trademarks were filed prior to the filing date of the Application.

18. Applicant's GROUP EDISON Mark incorporates Opposer's EDISON Trademarks as the dominant portion thereof, and is substantially similar to Opposer's EDISON Trademarks in appearance, sound, connotation and commercial impression.

09/20/2008 TAP

**AS AND FOR A FIRST GROUND FOR OPPOSITION
AGAINST THE APPLICATION**

OPPOSITION BASED ON LANHAM ACT § 2(D)

19. Opposer repeats and re-alleges each of the allegations contained in paragraphs 1 through 18 as if fully set forth herein.

20. Opposer and its predecessors, beginning at least as early as the turn of the Twentieth Century, commenced use of the EDISON Trademarks as applied to various goods for industrial, business or personal use. Opposer's use of the EDISON Trademarks has been valid and continuous since the adoption of such marks and has not been abandoned.

21. Through extensive and continuous use of the EDISON Trademarks by Opposer and its predecessors in the United States and worldwide, the EDISON Trademarks have become distinctive, famous and symbolic of substantial goodwill and consumer recognition as associated with Opposer.

22. When viewed in its entirety, the Applicant's Mark is substantially similar to the Opposer's Trademark.

23. In view of the similarity of the EDISON Trademarks and Applicant's Mark, and the nature of the goods of the respective parties, it is alleged that Applicant's Mark so resembles Opposer's EDISON Trademarks as to be likely to cause confusion, to cause mistake, or to deceive.

24. Opposer will be damaged by registration of Applicant's Mark on the Principal Register since by virtue of such registration, Applicant will be in a position to: (a) interfere with Opposer's continued exclusive use and enjoyment of its EDISON Trademarks and (b) raise doubts as to the exclusive rights of the Opposer to use and register its trademarks.

**AS AND FOR A SECOND GROUND FOR OPPOSITION
AGAINST THE APPLICATION**

OPPOSITION BASED ON LANHAM ACT § 2(A)

25. Opposer repeats and re-alleges each of the allegations contained in paragraphs 1 through 24 as if fully set forth herein.

26. Opposer, through its predecessors-in-interest, since at least the early 1900's, has been and is now conducting business under the EDISON Trademarks throughout the United States. This use has been valid and continuous since the adoption of said trademarks and the relevant class of consumers has come to associate Opposer with said Trademarks.

27. In view of the similarity of Applicant's Mark with Opposer's EDISON Trademarks, and in view of the nature of the parties' uses, therefore, it is alleged that Applicant's Mark consists of and comprises matter that may disparage and falsely suggest a connection with Opposer:

28. It is further alleged that Applicant's Mark so resembles Opposer's EDISON Trademarks as to be likely to cause confusion, to cause mistake, or to deceive.

**AS AND FOR A THIRD GROUND FOR OPPOSITION
AGAINST THE APPLICATION**

DILUTION UNDER LANHAM ACT § 43(C)

29. Opposer repeats and re-alleges each of the allegations contained in paragraphs 1 through 28 as if fully set forth herein.

30. Opposer's EDISON Trademarks, including the name, likeness, and signature of Thomas Edison, are famous and distinctive marks.

31. Applicant's alleged use of colorable imitations of the EDISON Trademarks began long after those marks had become famous. Applicant's actions dilute the distinctive quality of Opposer's EDISON Trademarks in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

32. Opposer will be irreparably damaged if Applicant's Mark is registered on the Principal Register, because when used, Applicant's Mark will dilute the distinctive quality of the EDISON Trademarks.

WHEREFORE, Opposer prays that the application of Richard H. Tamian, set forth herein for registration of the Applicant's GROUP EDISON (Stylized) Mark, be refused, and that this Opposition be sustained.

A duplicate copy of this Notice of Opposition and the required fee of \$300.00 (for 1 class) are enclosed herewith.

Please recognize as attorneys for Opposer, Glenn F. Ostrager, Dennis M. Flaherty, Joshua S. Broitman, Eric A. Lerner, Roberto L. Gomez, Milagros Cepeda and Manette Dennis and the law firm of Ostrager Chong & Flaherty LLP, 825 Third Avenue, New York, New York 10022-7519.

Dated: September 23, 2003
New York, New York

OSTRAGER CHONG & FLAHERTY LLP



By: _____
Eric A. Lerner

825 Third Avenue
New York, New York 10022-7519
(212) 826-6565

Attorneys for Opposer
McGraw-Edison Company

00/20/2000TAE

607/2010007148
Public Address "Edison, New York"

*From the Laboratory
Thomas A. Edison,
Orange, N.J.*

November 24, 1930

To Thomas A. Edison, Incorporated
West Orange, New Jersey

I have devoted many years of my life to research, experiments and invention.

I am informed and believe that the capital invested in American industries based upon or substantially affected by my inventions and discoveries exceeds twenty billion dollars. I realize that the public has for a great many years associated my name with the industries based upon my inventions and discoveries and also with the articles of commerce manufactured by the companies in which I am interested. I do not wish my name to be used for commercial purposes indiscriminately by concerns with which I have had no association. I realize that it is not unusual for persons and industries to appropriate without authority the name and portrait of public and well known persons as part of their corporate names or as trade marks for their merchandise. I realize also that the public has placed faith and credit in the industries that use my name with my authority and in the articles of commerce manufactured by the companies in which I am interested. I desire,

62-28000-271A2
Thomas A. Edison, Incorporated
p-2
November 24, 1930

as completely as possible, to protect the industries which rightfully use my name, to justify the public's faith in my name in these industries, and to prevent, as far as I may be able to do so, the unauthorized commercial use of my name, portrait and signature.

I have heretofore conveyed to you by certain instruments in writing dated January 1, 1930, the physical property constituting the Edison Laboratory, so that research and experimental work such as I have begun and been associated with may be continued as nearly as possible as I have conducted it and any good will I have gained in connection therewith may be conserved and perpetuated.

I have also assigned or am about to assign to you all the copyrights registered in my name or owned by me of all photographs and portraits of myself.

In furtherance of these purposes, I, Thomas A. Edison, of West Orange, New Jersey, therefore assign, transfer and convey to you, Thomas A. Edison, Incorporated, a New Jersey corporation, having your principal office at West Orange, New Jersey, your successors and assigns, all the rights not heretofore conveyed, in and to the names EDISON and THOMAS A. EDISON for commercial purposes and for the promotion of research and inventions in whatever forms the same may be used, including my signature, which is now extensively used as a trade mark by you; and also my rights in and to all portraits, photographs

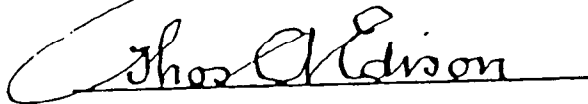
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Thomas A. Edison, Incorporated
p-3
November 24, 1930

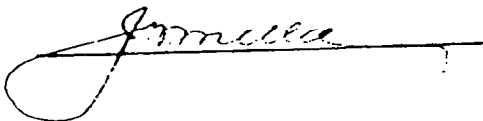
and pictures of myself.

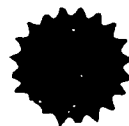
It is my desire that no persons or concerns, not duly authorized so to do, shall use my name, signature or portrait for commercial purposes unless permission be first obtained from you, your successors or assigns, and I trust that my wish will be respected, but if not I direct that unauthorized users of my name, signature or portrait be vigorously prosecuted.

Witness my hand and seal this 24th day of
November, 1930.

Witness:


Thomas A. Edison


J. M. Allen



ASSIGNMENT

For value received, I, THOMAS A. EDISON, of West Orange, New Jersey, have assigned, transferred, conveyed and set over and by these presents do assign, transfer, convey and set over unto THOMAS A. EDISON, INCORPORATED, a New Jersey corporation having its principal office at West Orange, in said State, any and all United States and foreign copyrights registered in my name or owned by me of any and all photographs, prints and pictorial illustrations depicting or portraying me, alone, in any group, or otherwise.

TO HAVE AND TO HOLD the same unto said Thomas A. Edison, Incorporated, its successors and assigns and other legal representatives forever.

WITNESS my hand and seal this 24th day of November, 1930.

Witness:

Thomas A. Edison



J. M. Miller

STATE OF NEW JERSEY)
COUNTY OF ESSEX) ss.:

BE IT REMEMBERED, that on this 24th day of November, in the year of Our Lord One Thousand Nine Hundred and Thirty, before me, a Notary Public for the State of New Jersey,

personally appeared THOMAS A. EDISON, who, I am satisfied, is the person mentioned in the foregoing instrument, to whom I first made known the contents thereof and thereupon he acknowledged that he signed, sealed and delivered the same as his voluntary act and deed, for the uses and purposes therein expressed.

Adm. Secy.

COPYRIGHT OFFICE OF THE UNITED STATES OF AMERICA A
LIBRARY OF CONGRESS—WASHINGTON

The foregoing assignment of copyright, dated November 24, 1930, and received for record in the Copyright Office on December 4, 1930, has been recorded in the Copyright Office, book 259, page s 156-157, in conformity with the laws of the United States respecting copyrights.

In Witness Whereof, the seal of this Office has been hereto affixed this sixth day of December, 1930.

Richard L. DeWolf
Register of Copyrights

B-2

TTAB

OSTRAGER CHONG & FLAHERTY

LIMITED LIABILITY PARTNERSHIP

PATENT, TRADEMARK AND
COPYRIGHT MATTERS

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ERIC LERNER
elerner@ocflaw.com



09-23-2003

September 23, 2003

U.S. Patent & TMOfr/TM Mail Rcpt Dt. #22

Box TTAB FEE
Commissioner For Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Re: Notice of Opposition
McGraw-Edison Co. v. Richard H. Tamian
For: GROUP EDISON (Stylized)
Serial No. 76/208,603

Sir:

Submitted herewith is the above-identified Notice of Opposition in duplicate.

Also enclosed are:

1. A check drawn on: X Ostrager Chong & Flaherty LLP for the filing fee (1 class) in the amount of \$300.00.
2. The Commissioner is authorized to charge any additional fees which may be required, or to credit any overpayment, to our Deposit Account No. 15-0699.
3. X CERTIFICATE OF EXPRESS MAILING:

I hereby certify that the aforementioned papers are being deposited with the United States Postal Service on the date shown below in an envelope addressed to: Box TTAB Fee, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

Certificate Number EV270962880US
Date September 23, 2003

Respectfully,

Eric A. Lerner